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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,208	12/31/2003	Neil Andrew Abercrombie Simpson	WEAT/0080.C2	9200

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William B. Patterson
MOSER, PATTERSON & SHERIDAN, L.L.P.
Suite 1500
3040 Post Oak Blvd.
Houston, TX 77056

EXAMINER

NEUDER, WILLIAM P

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 10/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/750,208

Applicant(s)

SIMPSON, NEIL ANDREW
ABERCROMBIE

Examiner

William P. Neuder

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-57 is/are pending in the application.
- 4a) Of the above claim(s) 45-54 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21-29, 34-39 and 56 is/are allowed.
- 6) ☒ Claim(s) 30-33, 40-44, 55 and 57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/22/05, 5/23/05
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Election/Restrictions

DETAILED ACTION

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 21-44 and 55-57, drawn to an apparatus and method of expanding using a rolling expander, classified in class 166, subclass 380.
- II. Claims 45 and 50-54, drawn to a dual expander, classified in class 166, subclass 207.
- III. Claims 46-49, drawn to a method of expanding tubulars having certain characteristics, classified in class 166, subclass 384.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Groups I, II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of group II has separate utility such as the expander could be used to expand pipelines. In the instant case, invention of Group III has separate utility in that the tubing having certain characteristics could be used to seal off casing leaks. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II and III, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Hardie on 10/11/05 a provisional election was made with traverse to prosecute the invention of Group I, claims 21-44 and 55-57. Affirmation of this election must be made by applicant in replying to this Office action. Claims 45-54 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 40,41 and 44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 40 and 41 call for "a biasing mechanism for biasing the radially extendable member". The only means to extend the radially extendable members is fluid pressure. While fluid pressure can be used to bias the members outward, fluid pressure is not a mechanism. Claim 44 calls for "a force storage mechanism for storing

at least a portion of the force. No means for storing energy can be found. Clarification is required.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification does not set forth "a biasing mechanism" found in claims 40 and 41. Also, the specification does not set forth the "force storage means" found in claim 44.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 30-32, 40-44, 55 and 57 are rejected under 35 U.S.C. 102(b) as being anticipated by Abdrakhmanov et al 5,083,608.

Abdrakhmanov discloses a method of completing a well. A bottom portion of tubing is expanded (see fig. 7) with a hydraulically actuated tool. The tool has a body 24 having a longitudinal bore (unnumbered) there through. Extendable members 29 are mounted on slidable pistons having a surface on which fluid pressure supplied through the bore acts to expand the members. As to claim 31, the members are extendable within a range and correspondingly expand the tubular within the range. As to claim 32, increased fluid pressure causes the expanders to extend further. As to claim 40, the

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members 29 having multiple positions depending upon the amount of fluid pressure supplied. The fluid pressure being the biasing mechanism. As to claim 33, the members 29 have a fully extended and fully retracted position. AS to claim 42, the tool is used to expand the tubular by use of hydraulic pressure to actuate the members 29. As to claim 43, the members 29 engage the inner diameter of the tubular. As to claim 44, the hydraulic pressure is a force storage means. As to claim 55, the tool is a compliant expander and at least two members 29 are present. As to claim 57, the members 29 are independently expandable depending upon the uniformity of the surrounding surface opposite each member.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Abdrakhmanov et al 9described above).

The tool of Abdrakhmanov could be moved to multiple positions within the well to expand the tubular at different positions. It would have been considered obvious to use the tool of Abdrakhmanov to expand tubing at multiple positions since the device is retractable to allow the device to pass through tubing that does not need expanded.

Allowable Subject Matter

Claims 21-29,34-39 and 56 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Neuder whose telephone number is 571-272-7032. The examiner can normally be reached on Tuesday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



William P Neuder
Primary Examiner
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W.P.N.